

Remarks

Claims 1-6 are in the application, of which claims 1, 4, and 5 are in independent form. Claims 1-6 stand rejected under 35 U.S.C. § 103(a).

Claims 1-6 are subject to a species restriction under 35 U.S.C. § 121, in response to which Species II (FIG. 3) was previously provisionally elected in the Amendment filed October 7, 2005.

Request for Removal of Finality of Rejection

In the first Office action, dated June 7, 2005, claims 1, 3, 4, and 5 were rejected as being unpatentable over U.S. Patent No. 2,532,981 of Wolfe, and claims 1-6 were rejected as being unpatentable over Wolfe in view of U.S. Patent No. 6,442,843 of Jue et al. The June 7, 2006 Office action stated that “Wolfe teaches a chain saw 1 including a chain saw bar 20 mounted to chain saw 1 via at least one mounting stud” and a “sliding member 25 [that] is biased towards the mounting stud.” The June 7, 2005 Office action did not specifically identify the alleged mounting stud of Wolfe, and applicant reasonably believed that the mounting stud of Wolfe referenced in the Office action was a stud that is not shown in the drawings but that connects the bar 20 to the chain drive unit via the three round mounting holes in the bar 20, which are shown in Fig. 2 of Wolfe at the right-hand end of the bar 20.

Based on this reasonable reading of the Office action and cited references, Applicant’s response to the June 7, 2005 Office action included arguments explaining why the original claims were patentable over the cited references. Claim 4 was amended to correct a minor drafting error without modifying the scope of the claim.

The Office has now repeated the grounds for rejection in its Office action dated December 23, 2005 and makes the Office action final. However, for the first time, the Office now identifies ring 33 of idler I of Wolfe as corresponding to the claimed “mounting stud.” Because the December 23, 2005 Office action is the first time that this basis for rejection has been clearly stated and because the Office’s interpretation of Wolfe could not have been discerned from the June 7, 2005 office action (nor is it a reasonable interpretation of Wolfe), applicant asserts that the final rejection includes a new ground for rejection. Applicant submits that the final rejection is therefore premature, and requests removal of the finality of the rejection and reconsideration of the claims in view of the amendments and arguments presented herein.

Amendments to the Specification

In the specification, paragraphs [0001.1] to [0001.4], paragraph [0005.1], and drawing FIG. 4 are added, without adding new matter. The text of paragraphs [0001.1] and [0001.4], and the drawing of FIG. 4, are copied from U.S. Patent No. 6,049,986 of Calkins et al., which was incorporated by reference at paragraph [0006] of the original application. The added text and drawing figure are imported from Calkins et al. to recite in the specification and show in the drawings certain elements recited in the claims, as amended herein, which specify that the mounting stud projects from a housing of the chain saw.

The text added at paragraph [0001.1] is found in Calkins et al. at column 3, lines 40-57. The text added at paragraph [0001.2] is found at column 4, lines 1-6 and 9-10 of Calkins et al. The text added at paragraph [0001.3] is found at column 5, lines 1-27 of Calkins et al. The text added at paragraph [0001.4] is found at column 4, lines 29-38 of Calkins et al. And new FIG. 4 is copied from FIG. 1 of Calkins et al.

Response to Rejections under 35 U.S.C. § 103(a)

Claims 1 and 3-5 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 2,532,981 of Wolfe (“Wolfe”). Claims 1-6 also stand rejected as being unpatentable over Wolfe in view of U.S. Patent No. 6,442,843 of Jue et al. (“Jue”). Applicant respectfully traverses these grounds for rejection and requests reconsideration in view of the clarifying amendments to independent claims 1, 4, and 5. The subject matter of the claims, as amended, is encompassed within the scope of the original claims and should, therefore, not raise new issues that would require further consideration or searching.

Claims 1-6

Applicant respectfully contends that Wolfe does not disclose or suggest all of the claim limitations. Amended claims 1 and 5 both recite a sliding member and a tensioning member that biases the sliding member “in a direction such that when the apparatus” is “mounted to a chain saw having a mounting stud projecting from a housing of the chain saw, *the sliding member is biased towards the mounting stud*”. (emphasis added). Claim 4, as amended, recites that the chain saw bar is mounted “to a housing of the chain saw via at least one mounting stud that projects from the housing” and is further limited to a sliding member and a first tensioning member that “*biases the sliding member towards the mounting stud*”. (emphasis added). Wolfe does not teach or suggest an apparatus with a sliding member

biased towards a mounting stud of the kind projecting from a housing of the chain saw, and therefore Applicant contends that claims 1, 4, and 5 are not unpatentable over Wolfe alone, or over Wolfe in view of Jue.

Applicant also disagrees with the Office's interpretation of Wolfe, as set forth in the December 23, 2005 Office action, in which the ring 33 of idler I is viewed as a mounting stud to which the bar 20 is mounted. It is well known in the prior art to mount a chain saw bar to a mounting stud of the chain saw, as described, for example, in Calkins et al. Applicant believes that the Office action improperly interprets the claim term "mounting stud" more broadly than is reasonable in view of the present specification. To avoid such a misinterpretation of the term "mounting stud," applicant has added new paragraphs [0001.1] to [0001.4], describing a prior art configuration with mounting studs 16 and 18, shown in new FIG. 4. Applicant notes that for purposes of the claims, the term "mounting stud" should be interpreted to include threaded and unthreaded studs, as well as other projections that serve as a bearing member, as described at added paragraph [0001.4].

Wolfe teaches sliding member (plate 25) that is adjacent to a first tensioning member (spring 40). When the chain saw bar (blade 20) is mounted, the first tensioning member (spring 40) does bias the sliding member (plate 25), but it does so in a direction opposite from where the bar is mounted to the chain saw housing via one or more mounting studs (not shown). As depicted in FIGS. 1 and 2, the sliding member (plate 25) is located near the tip of the chain saw bar and the first tensioning member (spring 40) is located between the sliding member (plate 25) and the bar (20). As such, the first tensioning member is only able to bias the sliding member in a direction opposite the mounting stud to which the bar is mounted. In contradistinction, claims 1, 4, and 5 recite a sliding member biased "towards the mounting stud." Wolfe does not teach this limitation. Moreover, due to the arrangement of the device of Wolfe, reversal of the direction of biasing would defeat the purpose of the sliding member 25 thereof and render it inoperable, in that the saw chain would no longer be tensioned. Therefore, the Office action fails to make out a *prima facie* case of unpatentability. Applicant respectfully requests that the rejections of claims 1, 4, and 5 be withdrawn. Because claims 2, 3 and 6 all depend from claims 1 and 5, and include additional limitations, applicant respectfully requests that the rejections of claims 2, 3 and 6 also be withdrawn.

Claims 2 and 6

With respect to claims 2 and 6, the Office action asserts that Jue teaches a plurality of recesses in the sliding member, that enable the sliding member to be ratcheted away from the mounting stud in step-like fashion. The Office action identifies notches 32, 34 of Jue as corresponding to the claimed recesses. However, the Office action fails to identify where in Jue it is taught or suggested that these notches cooperate with any other parts of Jue (such as latch member 22) for ratcheting in step-like fashion. Applicant is unable to identify in Jue any such teaching of ratcheting. While latch member 22 of Jue is described as engaging notches 32 and 34, a full and fair reading of Jue reveals that the latching engagement taught by Jue does not involve a ratcheting action, as claimed in the present application. (See Jue at column 3, lines 36-57 and column 5, lines 1-50).

Moreover, there is no teaching or suggestion in the references or motivation in the art for implementing the structure of Jue with that of Wolfe. Jue and Wolfe are directed to largely unrelated fields. Skilled persons would not readily appreciate how the sheathing invention of Jue could be implemented with the chain saw of Wolfe. There is no suggestion or motivation for the desirability of such a combination, and the utility of such a combination is not apparent. Therefore, applicant asserts that the Office action fails to make out a *prima facie* case of unpatentability of claims 2 and 6 and requests that the rejection be withdrawn.

Conclusion

Applicant requests removal of the finality of the previous rejection, entry of the amendments, and reconsideration of the claims in view of the foregoing arguments. Regardless of whether the finality of the December 23, 2005 rejection is withdrawn, applicant notes that the subject matter of the claims, as amended, is encompassed within the scope of the original claims and should, therefore, not raise new issues that would require further consideration or searching.

Applicant believes the application is in condition for allowance and respectfully requests the same. Applicant invites the examiner to contact the undersigned by telephone, in the event that the examiner believes there are any issues outstanding.

Respectfully submitted,

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